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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,771	01/09/2002	Christoph Raber	0756 C PCT Cont. US	3604

7590 07/09/2003

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EXAMINER

BONCK, RODNEY H

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/040,771	RABER, CHRISTOPH
	Examiner	Art Unit
	Rodney H. Bonck	3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11,13-96,98-109 and 111-113 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) Claim(s) 113 is/are allowed.
- 6) Claim(s) 1,3-8,10,11,13-42,45,56-58,60,62,63,67-90,94-96,98,99,104-106,108 and 111 is/are rejected.
- 7) Claim(s) 112 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 May 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 9,43,44,46-55,59,61,64-66,91-93,100-103,107 and 109.

DETAILED ACTION

The following action is in response to the amendment received May 30, 2003, Paper No. 7.

Priority

Applicant has added a reference in the specification to the parent application in order to obtain the benefit of the prior filing under 35 USC 120. This examiner was previously under the impression that this reference was the only thing lacking in applicant's priority claim. It has been brought to the examiner's attention, however, that for applications filed after November 29, 2000 this reference must be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application (37 CFR 1.78). Since applicant did not submit the reference within the required time period, priority cannot be granted under 35 USC 120. This application does not have the benefit of the earlier filing date of the PCT application and, therefore, priority under 35 USC 119 cannot be based on the German applications because this application was filed more than twelve months after the filing date of the German applications. If the reference to the prior-filed application was unintentionally delayed, the reference may be accepted. A petition to accept an unintentionally delayed claim under 35 USC 120 may be filed in accordance with 37 CFR 1.78(a)(3).

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Drawings

The corrected or substitute drawings (sheets 4 and 16) were received on May 30, 2003. These drawings are acceptable to the examiner.

Election/Restrictions

Claims 9, 43, 44, 46-55, 59, 61, 64-66, 91-93, 100-103, 107, and 109 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8, 10, 11, 13-42, 45, 56-58, 60, 62, 63, 67-90, 94-96, 98, 99, 104-106, and 108 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "consisting at least in part of", line 10 of claim 1 and lines 11-12 of claim 108, is indefinite. The term "consisting" excludes elements other than those listed, while the expression "at least in part of" implies that other structure could be present. This contradictory language could be corrected by changing "consisting" to – comprising --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-8, 10, 11, 13-15, 24, 25, 27-42, 45, 56-58, 60, 62, 63, 67-79, 83-90, 94-96, 104, 108, and 111 are rejected under 35 U.S.C. 102(e) as being anticipated by Aschoff et al.(US 2003/0089572 A1). The Aschoff et al. device discloses an apparatus for effecting relative movements of first and second parts, one of which is turnable relative to the other. A tracking device 28 is fixed relative to the first part 40 and a helix is associated with the second part 22. The helix includes a plurality of convolutions including first and second packages of neighboring convolutions, each of the packages consisting of abutting convolutions and the tracking device having a portion extending between at least two of the convolutions. Means 18 is provided for turning one part relative to the other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aschoff et al.('572). Aschoff et al. does not specify what resilient material is used for the helix. It is submitted that choosing an appropriate material for the helix would have been within the purview of the artisan and would not constitute a patentable change from the Aschoff et al. device. Thus the use of steel, plastic or ceramic is seen as obvious within the meaning of 35 USC 103.

Claims 80-82, 105, and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aschoff et al.('572) in view of Staak('671). The Aschoff et al. device does not appear to disclose the use of a sensor to monitor the position of the parts. In a similar device Staak provides a switch 47 that serves to indicate the position of the movable part. It would have been obvious to provide a sensor for the device of Aschoff et al., the motivation being to indicate the position of the movable part as a parameter for control of the driving motor 18.

Allowable Subject Matter

Claim 112 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 113 is allowed.

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Claims 16-23, 98, and 99 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:30AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-3597 for regular communications and (703)-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Rodney H. Bonck
Primary Examiner
Art Unit 3681

rhb
July 7, 2003